

REMARKS

This is in response to the Office Action of April 10, 2008. Claim 6 is cancelled, without prejudice. No new matter is introduced by this Amendment. With this Amendment, claims 1-4 are before the Examiner for reconsideration.

Substantial duplicates

On page 3 of the Office Action, the Examiner objects to claim 6 as being a substantial duplicate of claim 4. While Applicants respectfully disagree with the Examiner's contention in this regard, claim 6 has been cancelled in order to advance the prosecution of the present application.

Rejection over prior art

Claims 1-4 (among others) were rejected under 35 U.S.C. § 103(a) as being unpatentable over US 6,193,986 B1 (Sakurada) in view of US 4,379,755 (Yamada) and WO 01/58279 (Takahashi). The rejection is respectfully traversed.

Sakurada discloses a water-in-oil emulsion. See column 2, line 37; column 7, lines 32-42 ("mixing the aqueous phase with an oil phase ... to finally obtain a W/O-type emulsion"); and Sakurada claim 11. The Sakurada water-in-oil emulsions are distinct from the oil-in-water emulsions of the present invention. As the Examiner recognizes, Sakurada fails to teach or suggest an oil-in-water emulsion.

The oil-free gelatinizing agent of Yamada contains (a) hydrophilic sucrose fatty acid ester and (b) hydrophilic liquid polyhydric alcohol. In contrast, the sucrose acetate isobutyrate employed in the present invention is lipophilic, not hydrophilic. In lines 37-41 of column 1, Yamada refers to disadvantages such as non-homogeneity and poor feel arising from the use of lipophilic sucrose esters. The Yamada teaching of using hydrophilic sucrose fatty acid esters teaches away from the use of lipophilic sucrose esters as in the present invention.

As the Examiner recognizes, neither Sakurada nor Yamada teaches or suggests sucrose acetate isobutyrate as an emulsifying agent. The Examiner alleges that Takahashi discloses that

sucrose acetate isobutyrate is an equivalent emulsifying agent to the sucrose fatty acid esters taught by Sakurada, citing paragraph [0029] of Sakurada. Applicants respectfully disagree. Takahashi merely lists many different types of emulsifiers that can be used as alternatives or in combination *in the Takahashi technology*. The Takahashi reference teaches nothing at all about equivalence of emulsifiers *in the Ishikawa technology* (that is, Applicants' technology).

The Examiner has not established, either by scientific explanation or by evidence, that, *prima facie*, one of ordinary skill in this art, following the combined teachings of the applied references, would have been motivated to prepare an oil-in-water emulsion composition comprising a polyglycerol fatty acid ester and a fat or oil composition that includes a polyvalent unsaturated fatty acid component and sucrose acetate isobutyrate, wherein the amount of the sucrose acetate isobutyrate is set to be from 25 to 300 parts by weight, based on 100 parts by weight of the polyvalent unsaturated fatty acid component. *See, e.g., KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007) (it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does); *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967) (where the invention sought to be patented resides in a combination of old elements, the proper inquiry is whether bringing them together was obvious and not whether one of ordinary skill having the invention before him would find it obvious though hindsight to construct the invention from elements of the prior art); *cf. Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993), citing *Ex parte Gerlach* 212 USPQ 471 (Bd. App. 1980) ("At best, the examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at appellant's invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness That which is within the capabilities of one skilled in the art is not synonymous with obviousness.").

Moreover, it has been demonstrated – in the 'Declaration under 37 CFR 1.132' of Makoto Ishikawa filed with the Amendment of January 31, 2008 – that the use of sucrose acetate isobutyrate as required by all of Applicants' claims provides *unexpected beneficial results*. A copy of the Declaration is enclosed for the convenience of the Examiner.

Applicants respectfully submit that, based upon the current record, the rejection of claims 1-4 over the Sakurada and Yamada and Takahashi disclosures is not sustainable.

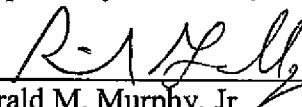
Conclusion

Early and favorable reconsideration of the merits of claims 1-4 is respectfully requested. Should there be any questions concerning the present application, the Examiner is respectfully requested to contact Richard Gallagher (Registration No. 28,781) at (703) 205-8008 in order to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By  #28,781
Gerald M. Murphy, Jr.

GMM/RG

Registration No.: 28,977

BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant